

Remarks:

Applicant has studied the Office Action dated September 12, 2006, and has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1-34 have been canceled. Claims 41 and 42 are added. No new matter has been added. Support for the new claims and the amendments are found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Drawings:

The Examiner objected to Figure 6 indicating that numeral ST7 is not supported in the specification. In response, Applicant has amended the last paragraph of page 15 in the Specification to recite the missing numeral. Accordingly, it is respectfully submitted that the objection to the drawings should be withdrawn.

§112 Rejection(s):

Claims 1, 5, 19, 35, 39 individually and claims 1-34 collectively are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1-34 are cancelled. As such, the respective rejection is moot. With reference to the remaining claims 35-42, the Examiner questions whether a "single cell organism" has emotions? Applicant cannot answer this question. It is possible that it does and it is quite possible that it doesn't. The former case falls within the scope of the claim, and the latter case does not.

Nevertheless, the Applicant respectfully submits that a person of ordinary skill would understand that information associated with emotions of a living organism comprise information about whether the living organism is happy, sad, hungry, excited, friendly, hostile, etc. The claim language should be interpreted in light of the specification and common knowledge (i.e., "common sense") available to person of ordinary skill, otherwise the Application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

Of course, as noted by the Examiner, the claims are a translation from a foreign language. The Applicant has done its best to amend the claims within the confines of the specification to more particularly recite the subject matter of the invention. It is respectfully submitted that despite the challenges associated with prosecuting an application based on a translation from a native language, the application is now in compliance with the requirements of §112, by the virtue of the present and past amendments.

If the Examiner feels that the term "living organism" or other terms used in the application are inaccurate or improper, the Applicant will consider the use of alternative terms that may be suggested by the Examiner, and requests constructive assistance pursuant to MPEP 706.03 (d) and 707.07(j).

With respect to the physical growth element recited in claim 38, one of ordinary skill would understand that a toy can physically grow in size by way of a mechanical instrument incorporate in one of the toy's physical limbs, elements or attributes. The Applicant respectfully submits that the 112 grounds of rejection are improper as the Applicant is not claiming subject matter that is within the realm of science fiction.

Allowable Subject Matter:

The Applicant wishes to thank the Examiner for finding claims 18 allowable if rewritten to overcome the above noted rejections and to include the elements of the base and intervening claims. Claim 18 now cancelled was dependent on claim 15 an independent claim which is also cancelled by the virtue of this amendment.

New claim 41 is dependent on claim 35, and incorporates the elements of claim 18 and claim 15. As such, 41 should be in condition for allowance.

§103 Rejection(s):

The pending claims are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of U.S. Patent No. 5,971,855 (Ng), U.S. Pub. No. 2002/0028704 A1 (Bloomfield), U.S. Patent No. 6,153,160 (Dureau), U.S. Patent No. 6,120,379 (Tanaka), and U.S. Patent No. 6,757,796 (Hofmann). The Examiner contends that it would have been obvious to combine the above five references and that the resultant combination discloses the claimed invention. This rejection is respectfully traversed.

Bloomfield was published on Mar. 7, 2002 and post-dates the present application with priority claims to two separate Korean applications, each filed on Aug. 17, 2000. The earliest claim of priority for Bloomfield is Sep. 5, 2000, which also post-dates the present application's effective filing date for the purpose of 103/102(e) rejection. For this reason alone, Bloomfield is an improper reference (i.e., it is not prior art) and the grounds of rejection on this basis should be withdrawn.

Furthermore, Bloomfield is directed to an information gathering scheme by which a user is encouraged to provide certain user profile data to an internet based database, such that the provided information helps keep a virtual agent, such as a pet, in a healthy state. In contrast, the present invention, as claimed, is related to a physical toy (NOT a virtual toy) and does not require the user to provide any personal or user profile information to be stored in an online database. As such, Bloomfield teaches away from the claimed invention.

Ng is directed to a combative video game in which a character that a user controls can fight with other characters in the game. Each character can win over or lose to its opponents based on a predetermined point scheme in which one or more points are gained or lost depending on the nature of activities the character is involved in, by way of the user's interaction with the video game controls. As such, other than the video game controls, the system of Ng does not involve a physical toy that can display or imitate human emotions, in response to data downloaded from the Internet.

Thus, the claimed invention is patentably distinguishable from Ng in that Ng fails to disclose a physical toy that can grow and show emotions in response to the user downloading information from the Internet by way of selecting advertisements displayed on the Internet. Furthermore, since Bloomfield is an improper reference, Bloomfield cannot be combined with Ng to cure deficiencies of Ng and to establish a *prima facie* case of obviousness.

Dureau teaches an "interactive television system" configured to display an "animated character" that has an appearance that changes from healthy to unhealthy in accordance with the amount of time a TV program is watched. This is to encourage a viewer to view certain programs and to provide feedback to a broadcasting station (see Abstract; col. 7, lns. 5-20; col.

8, lns. 30-55). Since Bloomfield is an improper reference, Dureau cannot be combined with Bloomfield to cure deficiencies of Ng and to establish a prima facie case of obviousness.

Hoffman is related to a method for “caching” data streamed during a broadcast over a communication network. The caching method is implemented to reduce the time delay experienced by a receiver before the streaming content is played (see Abstract; col. 1, lns. 35-55; col. 7, lns. 36-57). Since Bloomfield is an improper reference, Hoffman cannot be combined with Bloomfield to cure the deficiencies of Ng and to establish a prima facie case of obviousness.

Neither of the above cited five references either alone or in combination teach, suggest or disclose the claimed invention. Particularly, the references fail to disclose an adaptive toy system comprising (1) a body configured to convey desire information for at least one of (2) eating, (3) learning, and (4) playing; and (5) physically growing in response to receiving product information that satisfy the desire information; wherein a processing unit is connected to the body for (6) downloading the product information from (7) a web server and providing the information to the adaptive toy, wherein the web server receives said desire information and stores advertising banners for goods of various companies; and (8) wherein the adaptive toy comprises a communication means for outputting the desire information directly to the web server.

The applicant has carefully reviewed the five cited references. No portion of the cited references, either alone or in combination, teach or suggest the above enumerated elements as recited in claim 35. The Examiner is invited to point out the sections of each reference that teach the above elements with more specificity. Furthermore, the Examiner

has failed to point to any portion of the references that provides a motivation to combine all four references. MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings.” In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). Further, it is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since obviousness may not be established by hindsight reconstruction or conjecture, Applicant invites the Examiner to point out the alleged motivation to combine for all five references with specificity, or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.¹

¹ “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”

It is respectfully submitted that the fact that the Examiner has had to combine 5 references to form a basis for a rejection under section 103 is sufficient evidence that the claimed invention is not quite obvious. Further, the Examiner has failed to provide any reason why a person of ordinary skill would be motivated to combine the teachings of Ng directive to a combative video game with Dureau directed to an animated character for promoting viewing of a certain TV program. Also, there is also no indication in the Office Action why or how the above two references (Ng and Dureau) can be combined with the remaining three references (Bloomfield, Hoffman and Tanaka).

That is, there is no indication in the Office Action how such combination is possible, as the five systems are independently complex and cannot be easily modified to work with each other. Further, even if the five systems can be combined, the resultant combination will not function to accomplish the downloading of information related to goods and services from the internet to the toy. Particularly, the system disclosed by Dureau does not operate to connect to the Internet or download information from it. Therefore, the five references cannot be combined to teach the claimed invention.

For the above reasons, the invention as recited in claim 35 is distinguishable over the references cited by the Examiner. Claim 42 substantially incorporate the discussed limitations of claim 35 and therefore claims 35 and 42 should be in condition for allowance. Claims 36-41 depend on claims 35 and should also be in condition for allowance by the virtue of their dependence on an allowable base claim.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope

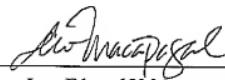
of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: January 10, 2007

By: 
Lew Edward V. Macapagal
Registration No. 55,416
Attorney for Applicant

Customer No. 035884